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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,608	10/19/2000	Takashi Hakuta	ZU-402	2117

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EXAMINER

LIPMAN, BERNARD

ART UNIT	PAPER NUMBER
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1713

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DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,608

Applicant(s)

HAKUTA ET AL.

Examiner

Bernard Lipman

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-- The MAILING DATE of this communication appears n th cover sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) 21-60,64,66,67,69,73,74,76 and 78-122 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20,61-63,65,70-72,75 and 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicants have traversed the requirement for election of species on the basis of the position that all the different uses of the composition are dependent on the composition and they all have the same special technical features. The Examiner maintains the position that the different uses inherently include various characteristics which are technically different and materially different and would, therefore, each represent the special technical features of their own. The restriction requirement represented by the elected species is, therefore, maintained herein and made FINAL.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was

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published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20, 61-63, 65, 68, 70-72, 75 and 77 are rejected under 35 U.S.C. 102(a) or (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsujimoto et al., U.S. Patent 6,013,729 or Tsutomu, Japanese JP 4154855 as represented by its Abstract.

Both references to Tsujimoto et al. and Tsutomu teach ethylene propylene diene terpolymers in compositions with cross-linking compounds which are the required siloxane compounds and catalysts therefor which meet applicants' required catalysts. Reference to Tsujimoto et al. specifically enumerates the norbornene type diene as required by applicants. Reference to Tsutomu specifically enumerates the compositions being suitable for cross-linking and vulcanization using hot air. Although neither of the references specifically teaches the required

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tensile hardness of the claims nor the other characteristics required by the claims in total, each of the references teaches the same types of compositions with the same polymers, the same cross-linking agents and the same catalysts for vulcanization which would result in a reasonable person of ordinary skill in the art coming to the conclusion that the characteristics of the compositions when cured would be the same. This reasonable presumption makes the claims properly rejected under 35 U.S.C. § 102 or 103 in the alternative as stipulated in the procedure under In re Fitzgerald et al., 205 USPQ 594. The Examiner having met his burden of showing a reasonable presumption that the compositions of the claims, the burden now shifts to applicants to show presentation of evidence that the compositions of the prior art do not, in fact, possess the characteristics as claimed or are structurally different than the compositions of the claims. Absent evidence to this effect, the claims are properly rejected under 35 U.S.C. § 102 or 103 as either anticipated or rendered prima facie obvious from the teaching of the references either separately or in combination. The use of the composition in electronics or electric applications is not specifically enumerated in the reference but would be prima facie obvious therefrom in view of the characteristics as required and taught by the references. The claims are, therefore, properly rejected under 35 U.S.C. § 102 or 103 over the references as cited.

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3. Claim 11 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite insofar as it is an improper multiple dependent claim. Claim 11 depends from more than one claim at a time insofar as it depends from one of claims 2-10 and claim 1. This dependency is improper and the claim, therefore, is properly rejected under 35 U.S.C. § 112 second paragraph.



Bernard Lipman
Primary Examiner
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BL:cdc
April 7, 2003